



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,507	02/23/2004	Ken Rosenblum	1326.001USS	1482
21186	7590	05/30/2008	EXAMINER	
SCHWEGMAN, LUNDBERG & WOESSNER, P.A. P.O. BOX 2938 MINNEAPOLIS, MN 55402				MAI, THIEN T
ART UNIT		PAPER NUMBER		
2887				
MAIL DATE		DELIVERY MODE		
05/30/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/784,507	ROSENBLUM, KEN	
	Examiner	Art Unit	
	Thien T. Mai	2887	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 19 February 2008.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-11 and 17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-11 and 17 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 23 February 2004 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/08</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgement

Acknowledgement is hereby made of Amendment and terminal disclaimer filed 02/19/2008.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim(s) 1-11 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Lion (US 6,330,491), further in view of Takamatsu et al. (US 4,567,358)

Re claim 1-6, Lion discloses a method comprising: sending prescription information for a therapeutic agent for a patient to a dispensing apparatus (col. 3 line 38-35);

giving the patient a unique authorization code (col. 3 lines 38-35); the patient entering the authorization code into the dispensing apparatus (Fig. 2);

wherein the authorization step is done without intervention of a pharmacist; wherein the patient receives the therapeutic agent from the dispenser without the intervention of a pharmacist (col. 2 lines 35-65); wherein the authorization code is given to the patient by a health care provider at a health care facility (mail order or online);

Lion is silent with respect to the authorization code not capable of being reused for other prescriptions.

However, Lion teaches that the authorization code for a prescription is obtained online after the customer making the online transaction for the prescription (col. 3 lines 38-35).

It would have been obvious to one of ordinary skill in the art at the time the invention was made that the authorization code/transaction code is incapable of being reused at least by the patient for other prescriptions since the patient is inherently required to get online again to make another transaction and get another “transaction code” for other prescriptions or other prescription not in the transaction);

Lion is further silent with respect to the patient being able to selectively cancel the transaction; and if the patient does not cancel the transaction, the patient receiving the prescribed therapeutic agent from the dispensing apparatus.

However, Lion discloses in Fig. 2 a dispensing apparatus having keypad that accepts authorization code from the customer (col. 3 line 38-35) and credit card information. It would have been obvious to one of ordinary skill in the art at the time the invention was made that when the keypad is non-functional or broken and/or the dispenser is incapable of recognizing an input from the customer, the customer would still have the prescription receipt obtained online or mail order and bring it to the store front where the dispenser is located and request the prescription to be filled. It would be further obvious a cancel button be incorporated in the keypad of the dispenser as commonly seen in ATM cash dispensers in order to allow the customer to back out a

process of keying information in the keypad which is especially useful for non-English speakers who do not understand the instructions prompted by the dispenser. Such ATM dispenser having a “Cancel” button is disclosed in at least Takamatsu et al. (see fig. 15-6).

Re claims 7-11, Lion discloses a method comprising:

providing a dispenser containing an inventory of therapeutic products; transmitting a proposed prescription for a patient to a server; authorizing dispensing of at least a portion of the proposed prescription out of the inventory in the dispenser if the prescription includes at least one therapeutic product available in the inventory of the dispenser;

providing to the patient an authorization code unique to the authorized prescription, the authorization code (i.e. transaction code obtained online -col. 3 line 38-35)

the patient inputting the authorization code into the dispenser and the patient entering separate patient authorization data (i.e. PIN or credit card number) into the dispenser; the dispenser determining whether the authorization code correlates to the patient authorization data; and

the dispenser delivering the available therapeutic product to the patient in response to the patient inputting the authorization code;

wherein the authorization step is done without intervention of a pharmacist; wherein the patient receives the therapeutic agent from the dispenser without the intervention of a pharmacist (col. 2 lines 35-65); wherein the authorization code is

given to the patient by a health care provider at a health care facility (mail order or online);

Lion is silent with respect to the authorization code not capable of being reused for other prescriptions.

However, Lion teaches that the authorization code for a prescription is obtained online after the customer making the online transaction for the prescription (col. 3 lines 38-35).

It would have been obvious to one of ordinary skill in the art at the time the invention was made that the authorization code/transaction code is incapable of being reused at least by the patient for other prescriptions since the patient is inherently required to get online again to make another transaction and get another “transaction code” for other prescriptions or other prescription not in the transaction); It is further noted that once a prescription has been filled, it is noted in the database as being expired (col. 6 lines 40+).

Allowable Subject Matter

3. Claim 17 is allowed.
4. The following is a statement of reasons for the indication of allowable subject matter: Prior art does not teach a method of printing traditional prescription by the dispensing apparatus when the patient cancels the transaction.

Remarks

5. Applicant's arguments have been fully considered but they are not persuasive.

Art Unit: 2887

6. In response to Applicant's arguments with respect to prior art does not disclose: the patient being able to selectively cancel the transaction, the Examiner notes that this method is too old and well known in the dispensers technology exemplified in a reference provided above, which allows a user backing out a transaction for any reasons when wanting not to continue with the transaction.

7. In response to applicant's argument that Lion does not teach the patient inputting authorization code and a separate patient authorization data, it is noted that Lion teaches both inputting transaction code/RxID obtained from cyber pharmacy and inputting patient ID and/or PIN number and credit card number. The credit card number is interpreted as the separate authorization data to complete the transaction. Furthermore, the Examiner notes that the method of entering multiple authorization code/data into the dispenser is disclosed by Lion. The more codes/data the patient has to input into the dispenser, the more protection from frauds/thefts is achieved; therefore the combination of different input codes/data disclosed by Lion is also found obvious and is within the skills of one in the art.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thien T. Mai whose telephone number is 571-272-8283. The examiner can normally be reached on Monday through Friday, 8:00 - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve S. Paik can be reached on 571-272-2404. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thien T Mai/
Examiner, Art Unit 2887

/Thien M. Le/
Primary Examiner, Art Unit 2887